

REMARKS

Applicants submit the above amendments and these remarks in response to the Office Action dated December 9, 2004. No fee is believed to be due in connection with this submission. In the event that any fees are determined to be due in connection with the filing of this response please charge necessary fees to Deposit Account No. 23-2415 referencing Docket No. 30923-715.201.

Claims 1-2, 7-26, 31, 32 and 34-48 are pending, with claims 1, 23, 24, 25, 47 and 48 being independent. By the above amendments, claims 3, 9, 27 and 33 have been canceled without prejudice to or disclaimer of the subject matter contained therein. Claims 1, 2, 8, 20, 23, 24, 25, 32, 47 and 48 are presently amended. Claims 2, 8, 20 and 32 have been amended to correct typographical errors and provide for correct antecedent basis. The amendments to claims 1, 23, 24, 25, 47 and 48 find basis in the original disclosure, *e.g.*, in the specification at p. 14, ll. 7-11 and p. 47, ll. 23 through p. 49, ll. 21 and in Fig. 19. No new matter has been added.

The above amendments have been made to expedite prosecution of certain embodiments of Applicant's invention and should not be construed as constituting any admission with respect to the patentability of the previously claimed subject matter. Applicants reserve the right to pursue cancelled subject matter in future applications.

1. The Claims Are Directed to Statutory Subject Matter

Claims 1-3, 7-27 and 31-48 were rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory matter. Specifically, the Examiner indicated that the rejected claims "are directed to a virtual library analysis" which contains various steps drawn "to selecting sets of compounds in the instant claims." The Examiner further indicated that the steps are "designations of compound sets without any concrete or tangible practice." Office Action at p. 2.

Applicant's respectfully disagree with the Examiner's position that claims directed to virtual library analysis are non-statutory for at least the reasons set forth in Applicant's previous response to Office Action dated September 10, 2004. However, in order to expedite prosecution of the pending application, Applicants have incorporated the Examiner's suggestion to recite *any* synthesis of at

least one compound selected by the method into independent claims 1, 23, 24, 25, 47 and 48. Accordingly, Applicant's respectfully request that the rejection under 35 U.S.C. § 101 be withdrawn.

2. The Claims Define Novel Subject Matter

The Examiner has rejected claims 1-3, 7-27, and 31-48 under 35 U.S.C. § 102(e)(2) as allegedly being anticipated by Cramer *et al.* (U.S. Patent No. 6,240,374). For the reasons set forth below, Applicants respectfully disagree.

As noted by the Federal Circuit, anticipation under 35 U.S.C. § 102 occurs only "when the same device or method, having all of the elements contained in the claim limitations, is described in a single prior art reference." *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367 (Fed. Cir. 2002). "A single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim." *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292 (Fed. Cir. 2002). Moreover, the "single reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art." *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116 (Fed. Cir. 2002).

The Examiner indicated that the Cramer *et al.* reference is "directed to a virtual library creation and searching for molecule with characteristics similar to a selected molecule." Office Action at p. 6. Specifically with regard to claims 1, 23-25, 47, and 48, the Examiner indicated that the Cramer *et al.* reference describes: "a non-enumerated virtual library generated from structural variations of any one synthetic reaction," "from this library a random selection is generated," "this selection is enumeration as a 0.001 fraction," "a fitness function in the form of bits evaluated in the Tanimoto fingerprint," "a subset of compounds is selected with certain Tanimoto similarities of 0.80 or higher or, alternatively other such criteria values," and a "structural core, and other structural building blocks defined as the core, fpcard and fp," "[s]imilarity searches to produce a screening or focused library," and the "number of focused or screening library fingerprint structural variations that are searched are enumerated." Office Action at pp. 6-7. With regards to claims 2 and 26, the Examiner further indicated that the Cramer *et al.* reference discusses "[a]n output of the results." Office Action at p. 7. With regards to claims 3 and 27, the Examiner indicated that the Cramer *et al.*

reference discusses “the selection of compounds.” Office Action at p. 7. And with regards to claims 7-9, the Examiner indicated that the Cramer *et al.* reference discusses the “output[ting] of results defined via similarity evaluation.” Office Action at pp. 7-8.

The virtual library described by the Cramer *et al.* reference, creates the library based on Topomeric CoMFA Descriptors and Tanimoto Fingerprint Descriptors. The library is then filtered by the removal of reactants for non-diversity reasons, removal of non-diversity reactants, removal of products for non-diversity reasons, and removal of non-diversity products. The next step involves merging libraries, and searching the virtual library. *See* Cramer *et al.* at col. 13-77. Nowhere does the reference teach or suggest synthesizing a compound selected from the process.

In contrast, amended claim 1 includes the step of “synthesizing at least one K compound.” Applicants note that because the Cramer *et al.* reference does not teach or suggest “selecting at least one K compound and synthesizing said at least one K compound,” the reference fails to teach or suggest each limitation of the pending claims and therefore does not anticipate or render obvious claim 1. Independent claims 23, 24, 25, 47 and 48 also include the step of “synthesizing” and therefore cannot be anticipated or rendered obvious by the Cramer *et al.* reference for the reasons set forth above. As none of the independent claims are anticipated by the Cramer *et al.* reference, none of the dependent claims can be anticipated. Accordingly, the rejection under 35 U.S.C. § 102(e)(2) should be withdrawn.

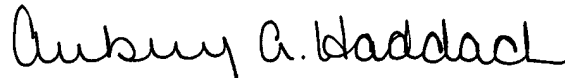
CONCLUSION

Applicants believe that for the reasons set forth above, claims 1-2, 7-26, 31, 32 and 34-48 are allowable. Prompt and favorable action is therefore respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (858) 350-2319.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Aubrey A. Haddach". The signature is fluid and cursive, with the first name "Aubrey" being more prominent.

Aubrey A. Haddach, Agent for Applicant
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Dated: March 9, 2005